

RECEIVED
CENTRAL FAX CENTER

DILLON & YUDELL LLP

NOV 05 2004

ATTORNEYS AT LAW

USPTO FACSIMILE TRANSMITTAL SHEET

TO:	M/S Appeal Briefs	FROM:	James E. Boice, Reg. No. 44,545
COMPANY:	US Patent and Trademark Office	DATE:	NOVEMBER 5, 2004
ART UNIT:	2111	TOTAL NO. OF PAGES INCLUDING COVER:	14
FAX NUMBER:	703-872-9306	APPLICATION SERIAL NO:	09/753,585
		ATTORNEY DOCKET NO:	JP919990174US1

☐ URGENT ☐ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY ☐ PLEASE RECYCLE

NOTES/COMMENTS:

Please see attached herewith:

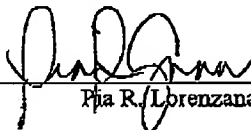
☒ Appeal Brief (13 pages).

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(A)]

☒ transmitted via facsimile on the date shown below to the United States Patent and Trademark Office at (703) 872-9306.

05 NOVEMBER 2004

Date


Pia R. Lorenzana

This fax from the law firm of Dillon & Yudell LLP contains information that is confidential or privileged, or both. This information is intended only for the use of the individual or entity named on this fax cover letter. Any disclosure, copying, distribution or use of this information by any person other than the intended recipient is prohibited. If you have received this fax in error, please notify us by telephone immediately at 512.343.6116 so that we can arrange for the retrieval of the transmitted documents at no cost to you.

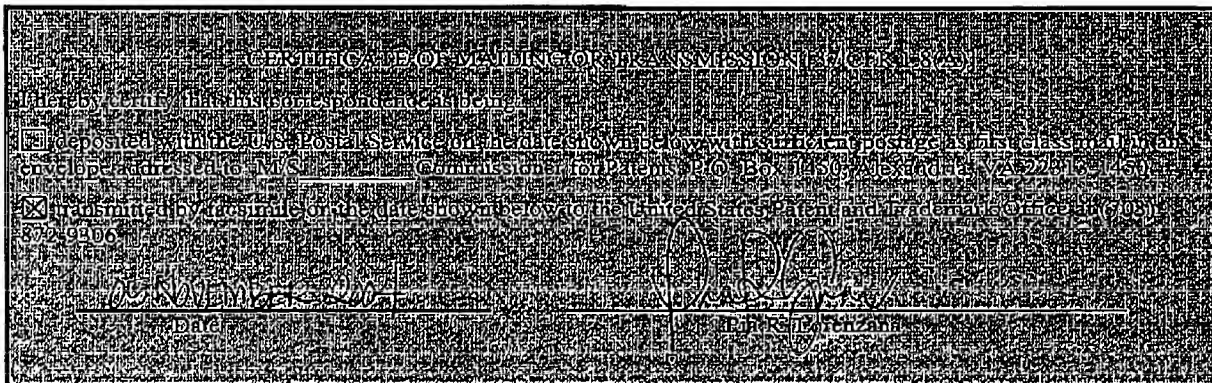
8911 N. CAPITAL OF TEXAS HWY., SUITE 2110, AUSTIN, TEXAS 78759
512.343.6116 (V) • 512.343.6446 (F) • DILLONYUDELL.COM

**RECEIVED
CENTRAL FAX CENTER**

NOV 05 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**ATTORNEY DOCKET NO.:
JP919990174US1****In re Application of:
SHIGEFUMI ODAOHARA**§
§
§
§
§
§
§
§
§
§**Examiner: RAYMOND NGAN PHAN****Serial No.: 09/753,585****Art Unit: 2111****Filed: 2 JANUARY 2001****For: POWER SOURCE SWITCHING
UNIT AND COMPUTER****APPEAL BRIEF UNDER 37 C.F.R. 1.192****Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450****Sir:**

This Appeal Brief is submitted in support of an Appeal of the Examiner's final rejection of claims 1-7 and 13-26 in the above-identified application. A Notice of Appeal was filed in this case on September 20, 2004. Please charge the fee of \$320.00 due under 37 C.F.R. § 1.17(c) for filing the Appeal Brief, as well as any additional required fees, to IBM Deposit Account No. 50-0563.



REAL PARTY IN INTEREST

The real party in interest in the present Appeal is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment recorded at reel 011676 and frame 0439 *et. seq.*

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, the Appellant's legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-12 were originally presented. In Appellant's Amendment A, filed on October 27, 2003, Claims 1-7 were amended, Claims 8-12 were cancelled, and Claims 13-26 were added. No further amendments to the claims were submitted in or subsequent to Appellant's second Amendment (Amendment B), dated April 8, 2004. Claims 1-7 and 13-26 stand finally rejected by the Examiner as noted in the Final Office Action dated July 23, 2004 and filed as paper number 13. The rejection of each claim is appealed.

STATUS OF AMENDMENTS

Appellant's Amendment A, filed on October 27, 2003, was entered by the Examiner. No amendments to the claims have been made subsequent to the final rejection that leads to this appeal.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The invention recited in exemplary amended Claim 1 provides a power source switching unit with an integrated charging circuit for selectively coupling an external power source, a computer load and one or more batteries, for providing temporary power during coupling, and for charging the one or more batteries. As is described, *inter alia*, at page 21, line 27 *et seq.* and illustrated at Figure 3, reference number 62, the unit includes an external power receiving unit to

APPEAL BRIEF

Docket No. AUS990832US1

Page 2 of 13

transfer electric power from an external power source to a power output to which a computer load is coupled. As is described, *inter alia*, at page 24, line 11 *et seq.* and illustrated at Figure 4, reference number 110, the unit further includes a detector, directly coupled to the power output of the external power receiving unit, to measure the voltage supplied by the external power receiving unit and detect a loss of the electric power supplied from the external power source to the external power receiving unit, wherein said detector detects the loss of the electric power supplied from the external power source to the external power receiving unit by measuring the voltage level supplied by the power output and comparing the voltage level to a fixed reference voltage, regardless of whether power is being supplied by the one or more batteries. As is described, *inter alia*, at page 23, line 9 *et seq.* and illustrated at Figure 3, reference number 64A and 64B, the unit includes one or more battery power supply circuits to selectively couple one or more batteries to the computer load and the one more batteries to an integrated charging device.

As is described, *inter alia*, at page 23, line 2 *et seq.* and illustrated at Figure 3, reference number 144, the unit further includes the integrated charging device, coupled to the power output and to the one or more battery supply circuits, wherein the charging device is capable of selectively trickle charging and rapid charging the one or more batteries with the electric power supplied from the power output. As is described, *inter alia*, at page 21, line 19 *et seq.* and illustrated at Figure 3, reference number 68, the unit includes a control unit to selectively cause the one or more battery supply circuits to couple the one or more batteries to the integrated charging unit during periods when the external power receiving unit is receiving electric power and to cause the one or more battery supply circuits to couple the one or more batteries to the computer load within a predetermined time in response to detector detecting a loss of the electric power supplied from the external power circuit. Finally, as is described, *inter alia*, at page 24, line 9 *et seq.* and illustrated at Figure 3, reference number 112, the unit includes a rechargeable temporary power supply device to supply electric power to the computer load for at least the predetermined time in response to the detector detecting the loss of the electric power supplied from the external power circuit.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

At paragraph 7 of the Examiner's final Office Action, the Examiner has rejected Claims 1-7 and Claims 13-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,202,171 to Townsley *et al.* (Townsley) in view of U.S. Patent No. 5,784,626 to Odaohara (Odaohara).

ARGUMENT

I. REJECTION OF CLAIMS 1-5, 7 AND CLAIMS 13-17 and 19-25 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER U.S. PATENT NO. 6,202,171 TO TOWNSLEY ET AL. (TOWNSLEY) IN VIEW OF U.S. PATENT NO. 5,784,626 TO ODAOHARA (ODAOHARA).

At paragraph 7 of the Examiner's final Office Action, the Examiner has rejected Claims 1-7 and Claims 13-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,202,171 to Townsley *et al.* (Townsley) in view of U.S. Patent No. 5,784,626 to Odaohara (Odaohara). Appellant respectfully submits that Claim 1 is not rendered unpatentable by the combination of Odaohara and Townsley, and Appellant most respectfully traverses the Examiner's rejections in view of the arguments and amendments submitted herein.

A. The cited combination of Odaohara and Townsley does not teach or suggest features of Appellant's invention, as recited in amended exemplary Claim 1.

1. The Examiner has failed to consider all words of Applicant's amended exemplary Claim 1.

In rejecting Claim 1, the Examiner has relied upon a combination of elements alleged to be present in Townsley with elements alleged to be present in Odaohara. Appellant respectfully submits that Claim 1 is not rendered unpatentable by the combination of Odaohara and Townsley, because the Examiner has failed to articulate a *prima facie* case of obviousness. As is well settled in the law, a *prima facie* case of obviousness for rejecting claims under 35 U.S.C. § 103 requires, *inter alia*, a showing that the prior art teaches or shows all of the claim limitations. *M.P.E.P.* § 2142. In demonstrating that the prior art teaches or shows all of the claim

APPEAL BRIEF

Docket No. AUS990832US1

Page 4 of 13

limitations, as stated in *M.P.E.P.* § 2143.03, citing *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), the Examiner is required to observe that “all words in a claim must be considered in judging the patentability of a claim against the prior art”(emphasis added).

In the present Office Action, the Examiner fails to meet his burden of making a *prima facie* case, because, rather than analyzing the features as recited in the *words* of Appellant’s *amended* claims, the Examiner alleges that *Townsley* shows “a charging device to charge at least one of the plurality of batteries with electric power supplied from the external power circuit” (Column 6, lines 10-57). Appellants have actually recited “an integrated charging device, coupled to the power output and to the one or more battery supply circuits, wherein the charging device is capable of selectively trickle charging or rapid charging the one or more batteries with the electric power supplied from the power output.” The Examiner has ignored Appellant’s claimed concept of selectively trickle-charging or rapid charging. Appellant respectfully traverses this rejection because the cited text of *Townsley* does not provide the functionality recited in Appellant’s *amended* claims.

2. *Townsley* does not show “an integrated charging device, coupled to the power output and to the one or more battery supply circuits, wherein the charging device is capable of selectively trickle charging or rapid charging the one or more batteries with the electric power supplied from the power output.”

Upon review of the cited passage, Appellants respectfully traverse the Examiner’s rejection, because the cited text does not teach or show an “integrated charging device, coupled to the power output and to the one or more battery supply circuits, wherein the charging device is capable of selectively trickle charging or rapid charging the one or more batteries with the electric power supplied from the power output.” *Townsley* does not explicitly disclose a charging circuit, leaving the Appellant or one skilled in the art to conclude that *Townsley*’s charging is performed by directly applying the V_Batt voltage from the AC adaptor 101 to the batteries 102 & 103, (*Townsley*, Figure 4). This teaches away from Appellant’s solution of “an integrated charging device, coupled to the power output and to the one or more battery supply circuits” (Figure 3, Element 144).

In response to Appellant's assertion that the "integrated charging device, coupled to the power output and to the one or more battery supply circuits, wherein the charging device is capable of selectively trickle charging or rapid charging the one or more batteries with the electric power supplied from the power output," is not shown in *Townsley*, the Examiner has further argued in his final Office Action that *Townsley* discloses "the charging device 115 coupled to the battery circuit (see figure 3, col. 6, lines 10-35); the teaching of trickle charging or rapid charging is well known to skilled in the art." Appellant respectfully submits that the Examiner's bare assertions of obviousness are not sufficient to establish a *prima facie* case of obviousness. As discussed above, neither the cited text, nor the cited figure contains an "integrated charging device, coupled to the power output and to the one or more battery supply circuits, wherein the charging device is capable of selectively trickle charging or rapid charging the one or more batteries with the electric power supplied from the power output." Appellants respectfully submit that the Examiner's conclusory statement that any differences between Appellant's claimed subject matter and the *Townsley* reference would be obvious to one skilled in the art fails to articulate a *prima facie* case of obviousness because the rejection does not show the recited feature as being present in any other reference *Townsley*, as is required by M.P.E.P. §2144.

The foregoing argument made with respect to Claim 1 is also believed to patentably distinguish similar Claims 13 and 20, and their respective dependent claims.

In summary, the Examiner's combination of *Townsley* and *Odaohara* fails to teach the invention recited in Appellants' Claim 1, or in similar Claims 13 and 20. The foregoing arguments made with respect to Claim 1, are also believed to apply to Claims 2-7, which depend from and patentably distinguish Claim 1, Claims 14-29, which depend from and patentably distinguish Claim 13, Claims 21-6, which depend from and patentably distinguish Claim 20,

II. REJECTION OF CLAIMS 6, 18, AND 26 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER TOWNSLEY IN VIEW OF ODAOHARA.

With regard to dependent Claims 6, 18 and 25, *Townsley* does not teach or show "a switching unit coupled to the power output and to one or more of the battery power supply circuits, wherein the switching unit prevents a short circuit of the integrated charging device while the integrated charging device is charging one or more of the batteries." This feature is not shown in *Townsley*, which, as stated above, does not employ "an integrated charging device, coupled to the power output," and therefore does not address the problem of a short circuit in such a charging device. The Examiner, in his final Office Action, contends that "*Townsley et al.* disclose a switch 132 which prevents the short circuit of charging device 115 (see figure 3, col. 7, lines 32-58). Appellant respectfully submits that the cited reference does not address preventing a short-circuit in a feature not shown in the reference.

CONCLUSION

Appellant has pointed out with specificity the manifest error in the Examiner's rejections, and the claim language which renders the invention patentable over the combination of references. Appellant, therefore, respectfully requests that the rejection of all pending claims be reversed.

Respectfully submitted,



James E. Boice
Re. No. 44,545
DILLON & YUDELL LLP
8911 N. Capital of Texas Highway
Suite 2110
Austin, Texas 78759
(512) 343-6116

ATTORNEY FOR APPELLANT

APPEAL BRIEF
Docket No. AUS990832US1
Page 7 of 13

CLAIMS APPENDIX

1. A power source switching unit with an integrated charging circuit for selectively coupling an external power source, a computer load and one or more batteries, for providing temporary power during coupling, and for charging the one or more batteries, comprising:

an external power receiving unit to transferelectric power from an external power source to a power output to which a computer load is coupled;

a detector, directly coupled to the power output of the external power receiving unit, to measure the voltage supplied by the external power receiving unit and detect a loss of the electric power supplied from the external power source to the external power receiving unit, wherein said detector detects the loss of the electric power supplied from the external power source to the external power receiving unit by measuring the voltage level supplied by the power output and comparing the voltage level to a fixed reference voltage, regardless of whether power is being supplied by the one or more batteries;

one or more battery power supply circuits to selectively couple one or more batteries to the computer load and the one more batteries to an integrated charging device;

the integrated charging device, coupled to the power output and to the one or more battery supply circuits, wherein the charging device is capable of selectively trickle charging and rapid charging the one or more batteries with the electric power supplied from the power output;

a control unit to selectively cause the one or more battery supply circuits to couple the one or more batteries to the integrated charging unit during periods when the external power receiving unit is receiving electric power and to cause the one or more battery supply circuits to couple the one or more batteries to the computer load within a predetermined time in response to detector detecting a loss of the electric power supplied from the external power circuit; and

a rechargeable temporary power supply device to supply electric power to the computer load for at least the predetermined time in response to the detector detecting the loss of the electric power supplied from the external power circuit.

2. The power source switching unit of claim 1, wherein the rechargeable temporary power supply device further comprises a capacitor coupled to the power output and the computer load.

3. The power source switching unit of claim 1, wherein the external power receiving unit is removably coupled to the computer load.
4. The power source switching unit of claim 1, wherein the rechargeable temporary power device further comprises a rechargeable battery.
5. The power source switching unit of Claim 1, wherein the external power receiving unit is supplied with alternating current electric power and discharges direct current electric power through the power output.
6. The power source switching unit of Claim 1, further comprising a switching unit coupled to the power output and to one or more of the battery-power supply circuits, wherein the switching unit prevents a short circuit of the integrated charging device while the integrated charging device is charging one or more of the batteries.
7. The power source switching unit of Claim 1, further comprising a direct current to direct current voltage converter coupled between the power output and the computer load.
- 8.-12. (Canceled)

13. A method of using a power source switching unit with an integrated charging circuit to selectively couple an external power source, a computer and one or more batteries, to provide temporary power during coupling, and to charge the one or more batteries, comprising:

an external power receiving unit transferring electric power from an external power source to a power output to which a computer load is coupled;

a detector, directly coupled to the power output of the external power receiving unit, measuring the voltage supplied by the external power receiving unit and detecting a loss of the electric power supplied from the external power source to the external power receiving unit, wherein said detector detects the loss of the electric power supplied from the external power source to the external power receiving unit by measuring the voltage level supplied by the power output and comparing the voltage level to a fixed reference voltage, regardless of whether power is being supplied by the one or more batteries;

one or more battery power supply circuits selectively coupling one or more batteries to the computer load and the one more batteries to an integrated charging device;

the integrated charging device, coupled to the power output and to the one or more battery supply circuits, selectively trickle charging and rapid charging the one or more batteries with the electric power supplied from the power output;

a control unit selectively causing the one or more battery supply circuits to couple the one or more batteries to the integrated charging unit during periods when the external power receiving unit is receiving electric power and causing the one or more battery supply circuits to couple the one or more batteries to the computer load within a predetermined time in response to the detector detecting a loss of the electric power supplied from the external power circuit, and

a rechargeable temporary power supply device supplying electric power to the computer load for at least the predetermined time in response to the detector detecting the loss of the electric power supplied from the external power circuit.

14. The method of claim 13, wherein the supplying step further comprises a capacitor coupled to the power output and the computer load supplying electric power to the computer load.

15. The method of claim 13, further comprising removably coupling the external power receiving unit to the computer load.

16. The method of claim 13, wherein the supplying step further comprises a rechargeable battery coupled to the power output and the computer load supplying electric power to the computer load.

17. The method of Claim 13, wherein the transferring step further comprises an external power receiving unit receiving alternating current electric power and discharging direct current electric power through the power output.

18. The method of Claim 13, further comprising a switching unit coupled to the power output and to one or more of the battery power supply circuits preventing a short circuit of the integrated charging device while the integrated charging device is charging one or more of the batteries.

19. The method of Claim 13, further comprising a high-voltage direct current to low-voltage direct current voltage converter, coupled between the power output and the computer load, converting voltage.

20. A data processing system including a power source switching unit with an integrated charging circuit for selectively coupling an external power source, a computer load and one or more batteries, for providing temporary power during coupling, and for charging the one or more batteries, comprising:

an external power receiving unit to transfer electric power from an external power source to a power output to which a computer load is coupled;

a detector, directly coupled to the power output of the external power receiving unit, to measure the voltage supplied by the external power receiving unit and to detect a loss of the electric power supplied from the external power source to the external power receiving unit, wherein said detector detects the loss of the electric power supplied from the external power source to the external power receiving unit by measuring the voltage level supplied by the power output and comparing the voltage level to a fixed reference voltage, regardless of whether power is being supplied by the one or more batteries;

one or more battery power supply circuits to selectively couple one or more batteries to the computer load and the one more batteries to an integrated charging device;

the integrated charging device, coupled to the power output and to the one or more battery supply circuits, wherein the charging device is capable of selectively trickle charging and rapid charging the one or more batteries with the electric power supplied from the power output;

a control unit to selectively cause the one or more battery supply circuits to couple the one or more batteries to the integrated charging unit during periods when the external power receiving unit is receiving electric power and to cause the one or more battery supply circuits to couple the one or more batteries to the computer load within a predetermined time in response to detector detecting a loss of the electric power supplied from the external power circuit, and

a rechargeable temporary power supply device to supply electric power to the computer load for at least the predetermined time in response to the detector detecting the loss of the electric power supplied from the external power circuit.

21. The data processing system of claim 20, wherein the rechargeable temporary power supply device further comprises a capacitor coupled to the power output and the computer load.
22. The data processing system of claim 20, wherein the external power receiving unit is removably coupled to the computer load.
23. The data processing system of claim 20, wherein the rechargeable temporary power device further comprises a rechargeable battery.
24. The data processing system of Claim 20, wherein the external power receiving unit is supplied with alternating current electric power and discharges direct current electric power through the power output.
25. The data processing system of Claim 20, further comprising a switching unit coupled to the power output and to one or more of the battery power supply circuits, wherein the switching unit prevents a short circuit of the integrated charging device while the integrated charging device is charging one or more of the batteries.
26. The data processing system of Claim 20, further comprising a direct current to direct current voltage converter coupled between the power output and the computer load.